

## **REMARKS**

Claims 1-47 and 49-64 are currently pending in this application. Claim 48 has been cancelled, and claims 34-38 and 40-47 have been amended in this response.

In the Office Action mailed December 7, 2004, claims 1-64 were rejected. More specifically, the status of the pending claims in light of this Office Action is as follows:

(A) Claims 34-64 were rejected under 35 U.S.C. § 101; and

(B) Claims 1-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,129,346 to Zorn ("Zorn") in view of U.S. Patent No. 6,421,652 to Loeb et al. ("Loeb").

The undersigned attorney wishes to thank the Examiner for engaging in telephone conferences on February 22 and 28, 2005, and requests that this paper constitute the applicant's Interview Summary. During these telephone conferences, the present Office Action, Zorn, and Loeb were discussed. The Examiner agreed that the Section 103(a) rejection of claims 1-64 over Zorn and Loeb will be withdrawn.

### **A. Response to the Section 101 Rejection**

Claims 34-64 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner alleges that "the first test of whether an invention is eligible for a patent is to determine if the invention is within the 'technical arts'. . . . In the present application, independent claims 34, 49, 52, 57 and 61 recite a 'useful, concrete and tangible result' (providing paper product with promotional material), however the claims recite no structural limitations (i.e., computer implementation), and so they fail the first prong of the test (technological arts)." (Office Action, pp. 2 and 5.)

35 U.S.C. § 101 recites, "Whoever invents or discovers any new or useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor." MPEP § 2106 provides some guidance as to what an article of "manufacture" includes:

### **(a) Statutory Product Claims**

Products may be either machines, manufactures, or compositions of matter.

A *manufacture* is "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties or combinations, whether by hand labor or by machinery." [citation omitted]

Claims 52-56 and 61-64 are directed to packages of paper products, and claims 57-60 are directed to packaged rolls of paper. These claims clearly fall within the definition of an article of "manufacture" set forth in MPEP § 2106. Furthermore, contrary to the Examiner's above-noted assertion, these claims include specific structural limitations. For example, claim 52 is directed to a package of paper products, including a plurality of stacked, unbound paper sheets, a wrapper disposed around the plurality of paper sheets, and promotional material disposed on the wrapper. The paper sheets are produced by a paper sheet manufacturer and purchased by a paper purchaser. The wrapper is positioned to at least partially enclose and protect the plurality of paper sheets. The promotional material has a content configured to identify and/or promote goods and/or services of a third-party advertiser different from the manufacturer and different from the paper purchaser. Accordingly, the Section 101 rejection of claims 52-64 should be withdrawn because (a) the claims fall within the definition of an article of manufacture as set forth in MPEP § 2106, and (b) the claims include structural limitations.

Claims 31-51 are directed to methods for providing paper products with promotional materials. In rejecting these claims, the Examiner states that because the claims fail to recite structural limitations, the claims fail the "technological arts" test. The undersigned attorney respectfully requests that the Examiner point to a specific section of the MPEP to support his assertion that methods must recite structural limitations to qualify as statutory subject matter.

The Examiner alleges that *In re Toma*, 197 USPQ 852 (CCPA 1978), established a "technological arts" test, which requires claims to recite a computer implementation. *Toma* did not establish such a test. Although the court in *Toma* found that the claimed

computer implemented process was within the "technological arts" because the claimed invention was an operation performed within a computer, the court did not hold that a process performed without a computer would not be within the "technological arts." Accordingly, claims 31-51 are directed to statutory material and the Section 101 rejection of these claims should be withdrawn.

C. Response to the Section 103(a) Rejection

Claims 1-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zorn in view of Loeb. In light of the agreement reached with the Examiner during the February 28 telephone conference, the Section 103(a) rejection of these claims will be withdrawn because the combination of Zorn and Loeb fails to disclose or suggest all the features of the claims. For example, with respect to claim 52, the combination of Zorn and Loeb fails to disclose or suggest a plurality of stacked, unbound paper sheets, a wrapper disposed around the plurality of paper sheets, and promotional material disposed on the wrapper.

D. Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 101 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-6465.

Respectfully submitted,

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